

**REMARKS**

This Application has been carefully reviewed in light of the Final Office Action mailed November 4, 2005. At the time of the Final Office Action, Claims 1-18 were pending in this Application. Claims 1-18 were rejected. Claims 1, 12 and 18 have been amended to further define various features of Applicant invention. Applicant respectfully requests reconsideration and favorable action in this case.

**Rejections under 35 U.S.C. § 102**

Claims 1-4, 8, 10, and 12-14 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,760,995 issued to Kenneth L. Heller et al. (“Heller et al.”). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention. The presently claimed embodiment of the invention is directed, *inter alia*, to: (a) a data storage system consisting of, *inter alia*, a “transfer unit having a vertically traveling carriage” (Claim 1); and (b) a data storage system comprising, *inter alia*, a “transfer unit having an elevator adapted to travel along a first axis, and a carriage adapted to travel along a second axis, said second axis running perpendicular to the first axis ...” (Claim 12). Heller fails to disclose and/or suggest such a system. Indeed, Heller’s “carriage” is stationary in relation to the elevator, i.e., it does not move. Heller’s tape drives and tape slots must include eject mechanisms because Heller’s elevator lacks a carriage that moves horizontally and/or along an axis perpendicular to the axis the elevator moves along. Thus, Heller does not teach each and every limitation of Claims 1 and 12 and withdrawal of the rejection is requested.

Claim 18 is now directed to an advantageous embodiment of the invention which is made possible by Applicants’ transfer unit comprising an elevator to move, e.g., up and down, and a carriage to move another direction, e.g., from front to back or side to side. And Applicants’ embodiment claimed in Claim 18 is directed to a system wherein the “storage media” are of at least two different types, e.g., a DVD or CD and secondly, a tape. Applicants’ claimed “transfer unit” provides a system which, due to the fact that both the elevator and carriage move, can accommodate the transfer of different storage media to

different functional modules, e.g., a DVD to a DVD player and/or a tape to a tape drive, in a single system wherein the physical dimension of the storage media and functional modules differ. Heller does not teach such a system. Favorable action is requested.

Claims 1, 12 and 15-18 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,166,877 issued to Keiji Tadokoro et al. ("Tadokoro et al."). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention. All claims are directed to an embodiment of the invention including a "shaft" between a "front chamber" housing storage media modules, e.g., DVD or CD modules, and a "rear chamber" housing a function module, e.g., a DVD drive module. In the "shaft," a transfer unit is located to transfer DVD's to and from storage and a drive. Tadokoro et al. fails to teach and/or suggest such a system, e.g., Tadokoro et al., do not teach a "shaft ... arranged between the front and rear chamber." See for example Figures 4 and 5 of Tadokoro et al. As shown, Tadokoro et al.'s drives and cassette storage are located together not opposite one another with a shaft running therebetween.

In relation to Claim 18, in addition to the above argument, Claim 18 is patentable over the art because Tadokoro et al. fails to teach a system having more than one type of storage media as claimed. Favorable action is requested.

### **Rejections under 35 U.S.C. §103**

Claims 5-7, 9 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heller et al. Applicants respectfully traverse and submit the cited art does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Here, all the limitations of the Claims are not found in Heller et al. Heller, as set forth above, fails to teach the "transfer unit" of the present invention. Thus, withdrawal of the rejection is requested.

**Request for Continued Examination**

Applicant encloses a Request for Continued Examination (RCE) Transmittal, along with a check in the amount of \$395.00 (small entity) for the filing fee.

**CONCLUSION**

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the claims as amended.

Applicant encloses a Petition for Extension of Time (one month) and a check in the amount of \$60.00 for the extension fee. Applicant believes there are no other fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

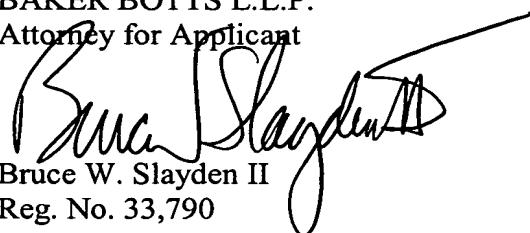
ATTORNEY DOCKET  
074623.0104

PATENT APPLICATION  
10/081,595

10

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2606.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicant

  
Bruce W. Slayden II  
Reg. No. 33,790

SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.  
CUSTOMER ACCOUNT NO. **23640**  
512.322.2606  
512.322.8306 (fax)

Date: 2/11/2005